Our Case No. 10580/3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Bernard Bud Bendiner)
)
Serial No. : 09/336,612)
) Examiner: La Toya I. Cross
Filing Date: June 18, 1999)
) Group Art Unit No.: 1743
For: SORBIC ACID AND/OR ITS)
DERIVATIVES, SUCH AS)
POTASSIUM SORBATE, AS A)
PREVENTATIVE FOR RUST,)
CORROSION AND SCALE ON)
METAL SURFACES)

DECLARATION UNDER 37 CFR 1.132

I, BERNARD BENDINER, hereby declare that:

1. I am the sole inventor of the subject matter claimed in U.S. Patent Application Serial No. 09/336,612 filed on June 18, 1999.

2. A CONTINUED PROSECUTION APPLICATION (CPA) for Application Serial No. 09/336,612 was filed on August 9, 2000.

3. In a FINAL OFFICE ACTION dated May 9, 2000, claims 1 and 2 of Application Serial No. 09/336,612 were FINALLY rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 3,630,226 to Develter and also under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,354,902 to Merciadez et al.

4. On June 28, 2000, an AMENDMENT AFTER FINAL REJECTION was filed in Application Serial No. 09/336,612 in which it was pointed out that, in response to the Office Action dated November 26, 1999, it was argued that the invention recited in claims 1 and 2 involves an unexpected, surprising and unusual result that is not shown in the prior art and was not obvious to one having ordinary skill in the art. It was also pointed out in the June 28, 2000 response that the specification for Application Serial No. 09/336,612 includes hard evidence of the new and unexpected results that clearly rebut the *prima facie* case of obviousness upon which both rejections of claims 1 and 2 were based.

5. An Advisory Action dated July 26,200 was received in response to the AMENDMENT AFTER FINAL REJECTION. In this Advisory Action, it is stated that the evidence contained in Application Serial No. 09/336,612 shows unexpected results as a result of subjecting steel and metal nails to Applicant's PS solution subjected to tap water only. It is suggested in the Advisory Action that evidence should be submitted to show unexpected results over the solutions of the applied prior references.

6. The Examiner's suggestion has been followed and the results of these tests are hereby presented.

7. The following solution, from columns 3 and 4 of the Merciadez et al. Patent No. 5,354,902 was prepared:

Ingredients	**% by Weight**
Sucrolase	25.000
Potassium Sorbate	0.110
Sodium Bensoate	0.110
Citric acid, anhydrous	0.272
Sodium citrate, dehydrated	0.258
Purified Water	74.250

The pH of the above aqueous solution was tested and found to be 4.4.

A portion of this solution was placed in a first glass beaker.

8. To the solution described in paragraph 7 above, 1PPM of Mn++ions was added and a portion of this solution was placed in a second glass beaker.

9. To the solution described in paragraph 7 above, 3PPM of Mn++ions was added and a portion of this solution was placed in a third glass beaker.

10. To the solution described in paragraph 7 above, 5PPM of Mn++ions was added and a portion of this solution was placed in a fourth glass beaker.

11. Exhibit A is a colored photograph showing the first glass beaker with an identification card below it labeled "Photo #1". Laying on the identification card are several ungalvanized nails.

12. Exhibit A is a colored photograph showing the second glass beaker with an identification card below it labeled "Photo #2". Laying on the identification card are several ungalvanized nails.

13. Exhibit A is a colored photograph showing the third glass beaker with an identification card below it labeled "Photo #3". Laying on the identification card are several ungalvanized nails.

14. Exhibit B is a colored photograph showing the second glass beaker with an identification card below it labeled "Photo #2". Laying on the identification card are several ungalvanized nails.

15. Exhibit B is a colored photograph showing the third glass beaker with an identification card below it labeled "Photo #3". Laying on the identification card are several ungalvanized nails.

16. Exhibit B is a colored photograph showing the fourth glass beaker with an identification card below it labeled "Photo #4". Laying on the identification card are several ungalvanized nails.

17. The ungalvanized nails shown in Exhibits A and B were placed in the associated glass beakers at 8:00 a.m. on August 8, 2000.

18. Exhibit C is a colored photograph of the first glass beaker that was taken at 8:00 a.m. on August 9, 2000. The rust on the ungalvanized nails and in the solution is clearly visible in this photograph.

19. Exhibit D is a colored photograph of the second glass beaker that was taken at 8:00 a.m. on August 9, 2000. The rust on the ungalvanized nails and in the solution is clearly visible in this photograph.

20. Exhibit E is a colored photograph of the third glass beaker that was taken at 8:00 a.m. on August 9, 2000. The rust on the ungalvanized nails and in the solution is clearly visible in this photograph.

21. Exhibit F. is a colored photograph of the fourth glass beaker that was taken at 8:00 a.m. on August 9, 2000. The rust on the ungalvanized nails and in the solution is clearly visible in this photograph.

22. Exhibit G is a colored photograph of the ungalvanized nails, above the identification card labeled "Photo #1", that were removed from the first glass beaker after the completion of the test at 8:00 a.m. on August 9, 2000.

23. Exhibit H is a colored photograph of the ungalvanized nails, above the identification card labeled "Photo #2", that were removed from the second glass beaker after the completion of the test at 8:00 a.m. on August 9, 2000.

24. Exhibit I is a colored photograph of the ungalvanized nails, above the identification card labeled "Photo #3", that were removed from the third glass beaker after the completion of the test at 8:00 a.m. on August 9, 2000.

25. Exhibit J is a colored photograph of the ungalvanized nails, above the identification card labeled "Photo #4", that were removed from the fourth glass beaker after the completion of the test at 8:00 a.m. on August 9, 2000.

26. The following solution for further proof of Applicant's new and unexpected results was prepared:

Ingredients	**% by Weight**
Potassium Sorbate	0.110
Purified Water (pH = 4.0)	99.890
	100.000

A portion of this solution was placed in a fifth glass beaker.

27. The following solution based upon column 4, lines 27-47 of the Develter Patent No. 3,630,226 was prepared:

Ingredients	**% by Weight**
Potassium Sorbate	0.3
Vinegar	1.7
Purified Water (pH = 4.0)	98.0
	100.000

A portion of this solution was placed in a sixth glass beaker.

28. Exhibit K is a colored photograph showing the fifth glass beaker with an identification card below it labeled "Photo #5". Laying on the identification card are several ungalvanized nails.

29. Exhibit K is a colored photograph showing the sixth glass beaker with an identification card below it labeled "Photo #6". Laying on the identification card are several ungalvanized nails.

30. The ungalvanized nails shown in Exhibits K were placed in the associated glass beakers at 8:00 a.m. on August 8, 2000.

31. Exhibit L is a colored photograph of the fifth glass beaker that was taken at 8:00 a.m. on August 9, 2000. The rust on the ungalvanized nails and in the solution, described in paragraph 26, is clearly visible in this photograph.

32. Exhibit M is a colored photograph of the sixth glass beaker that was taken at 8:00 a.m. on August 9, 2000. The rust on the ungalvanized nails and in the solution, described in paragraph 27, is clearly visible in this photograph.

33. Exhibit N is a colored photograph of the ungalvanized nails, above the identification card labeled "Photo #5", that were removed from the fifth glass beaker after the completion of the test at 8:00 a.m. on August 9, 2000. The rust on the ungalvanized nails that were in the solution, described in paragraph 26, is clearly visible in this photograph.

34. Exhibit N is a colored photograph of the ungalvanized nails, above the identification card labeled "Photo #6", that were removed from the sixth glass beaker after the completion of the test at 8:00 a.m. on August 9, 2000. The rust on the ungalvanized nails that were in the solution, described in paragraph 27, is clearly visible in this photograph.

35. Exhibit O is a colored photograph of the above described six glass beakers with the various solutions and the rusted ungalvanized nails at the completion of the test at 8:00 a.m. on August 9, 2000.

36. I submit that, in accordance with the suggestion contained in the above-mentioned Advisory Action that is signed by U.S. Patent Office Primary Examiner, Ms. Maureen M. Wallenhorst, I have hereby submitted proof that the solutions of the applied references, U.S. Patent No. 5,354,902 and U.S. Patent No. 3,630,226 do not provide the new and unexpected results that are claimed for my solution that is recited in claims 1 and 2 of Patent Application Serial No. 09/336,612.

37. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

AUGUST 28, 2000
(Date)

Bernard Bendiner

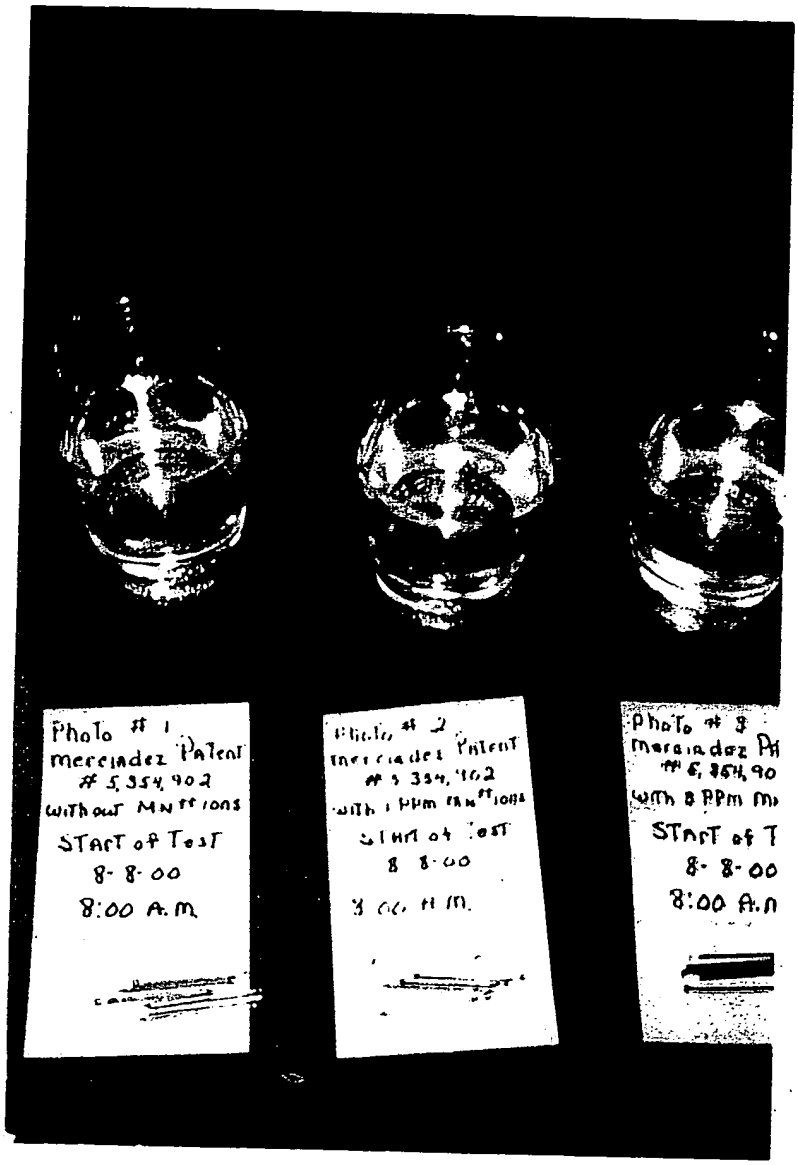


Photo # 1
mercadez Patent
5,354,902
without MANIFOLDS
START of Test
8-8-00
8:00 A.M.
Photo # 2
mercadez Patent
5,354,902
with 1 PPM MANIFOLDS
START of Test
8-8-00
8:00 A.M.
Photo # 3
mercadez Pat
5,354,90
with 8 PPM M
START of T
8-8-00
8:00 A.M

EXHIBIT A


PhoTo # 3
merciadez PaTenT
5,354,902
with 3 PPm MN++IONS
STaRT of TesT
8-8-00
8:00 A.M.
PhoTo # 4
merciadez PaTenT
5,354,902
With 5 PPm MaTTeRS
STaRT of TesT
8-8-00
8:00 A.M.

EXHIBIT B

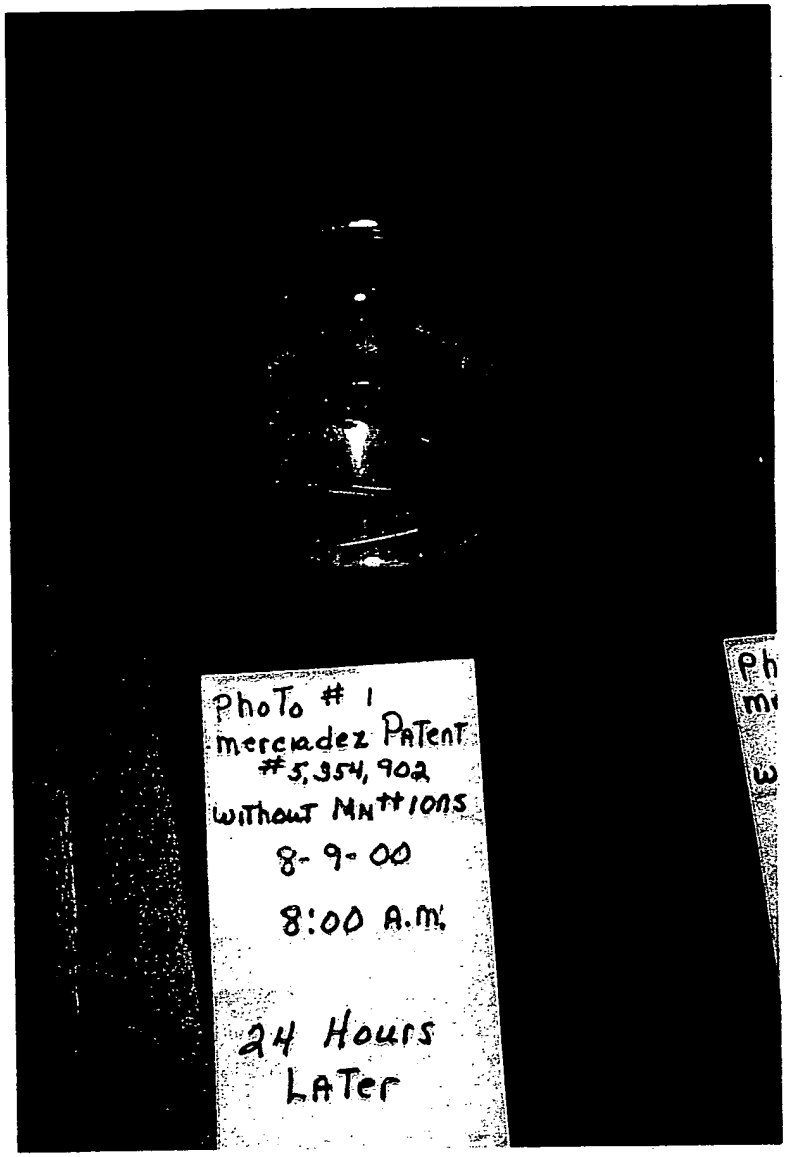
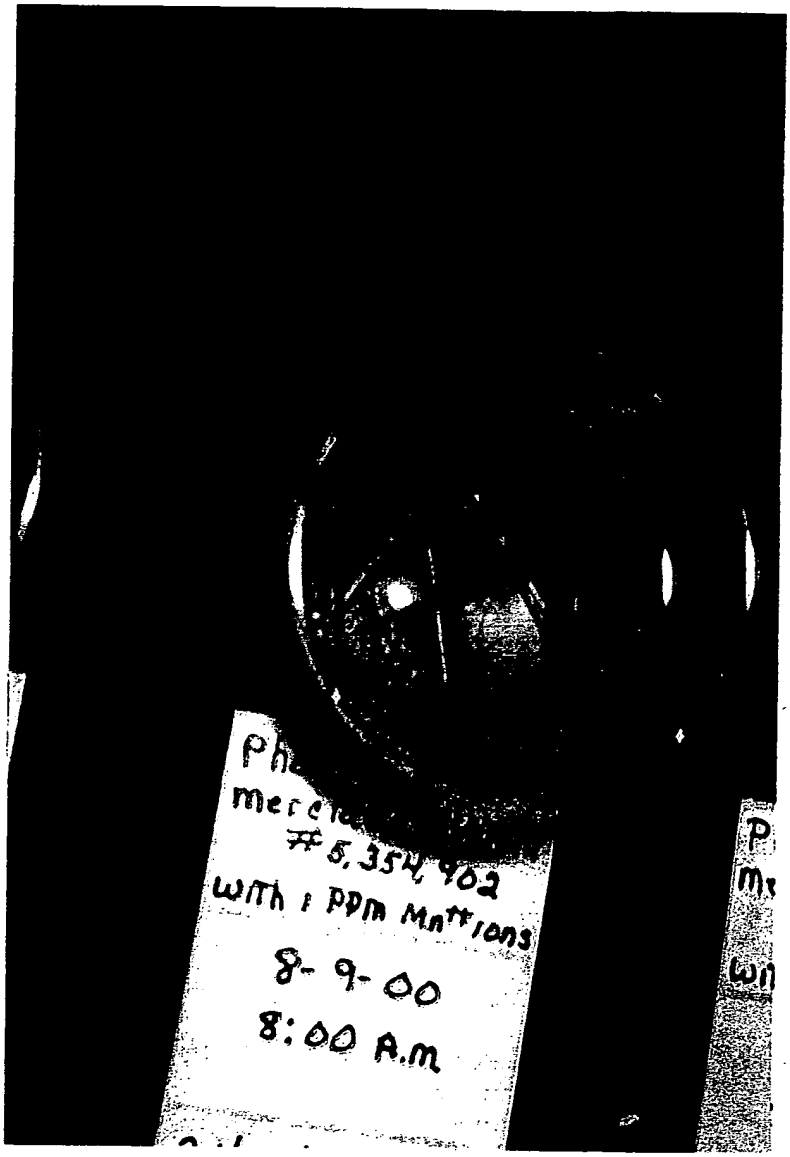


PhoTo # 1
mercadez PaTenT
#5,954,902
WiThouT MoTTIONS
8-9-00
8:00 A.M.
24 Hours
LATer

EXHIBIT C



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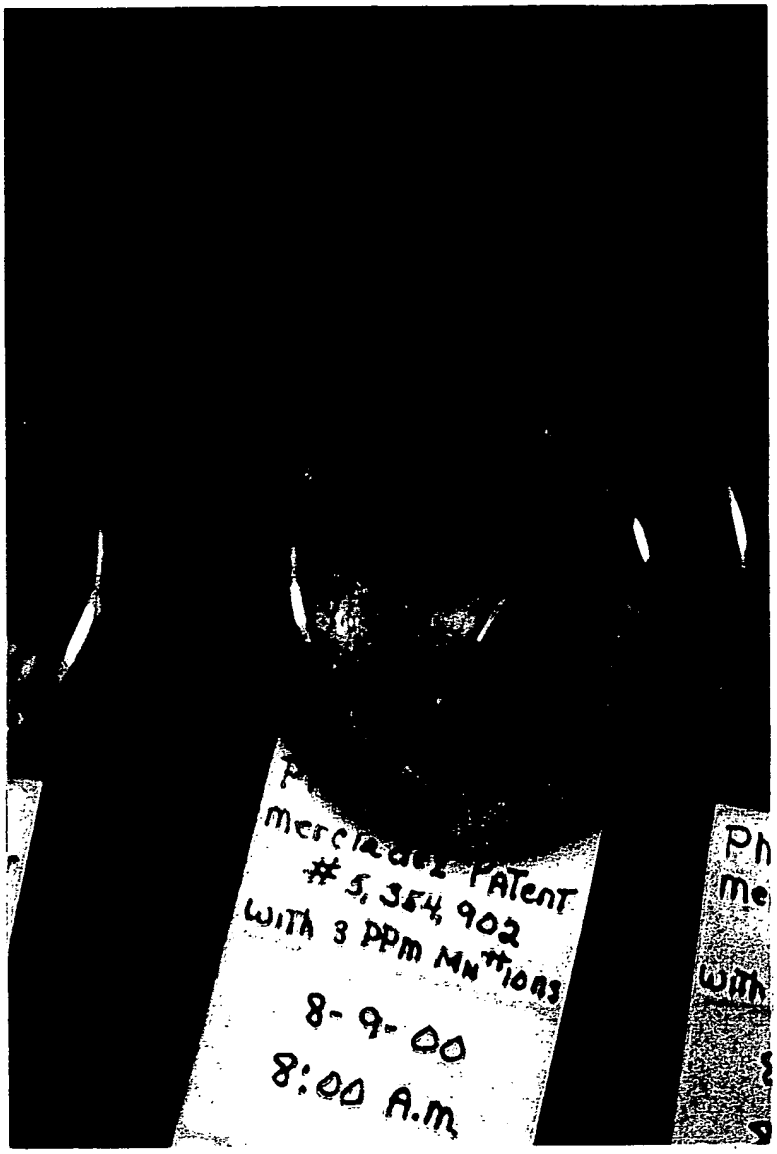

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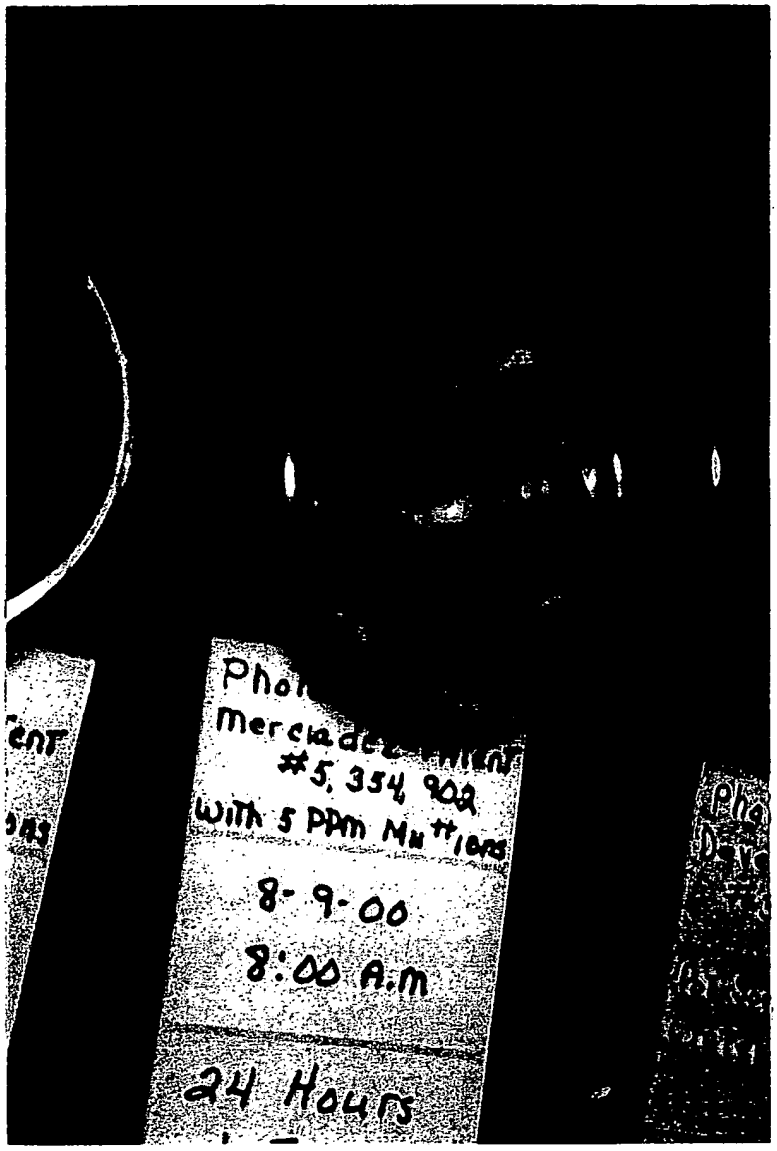

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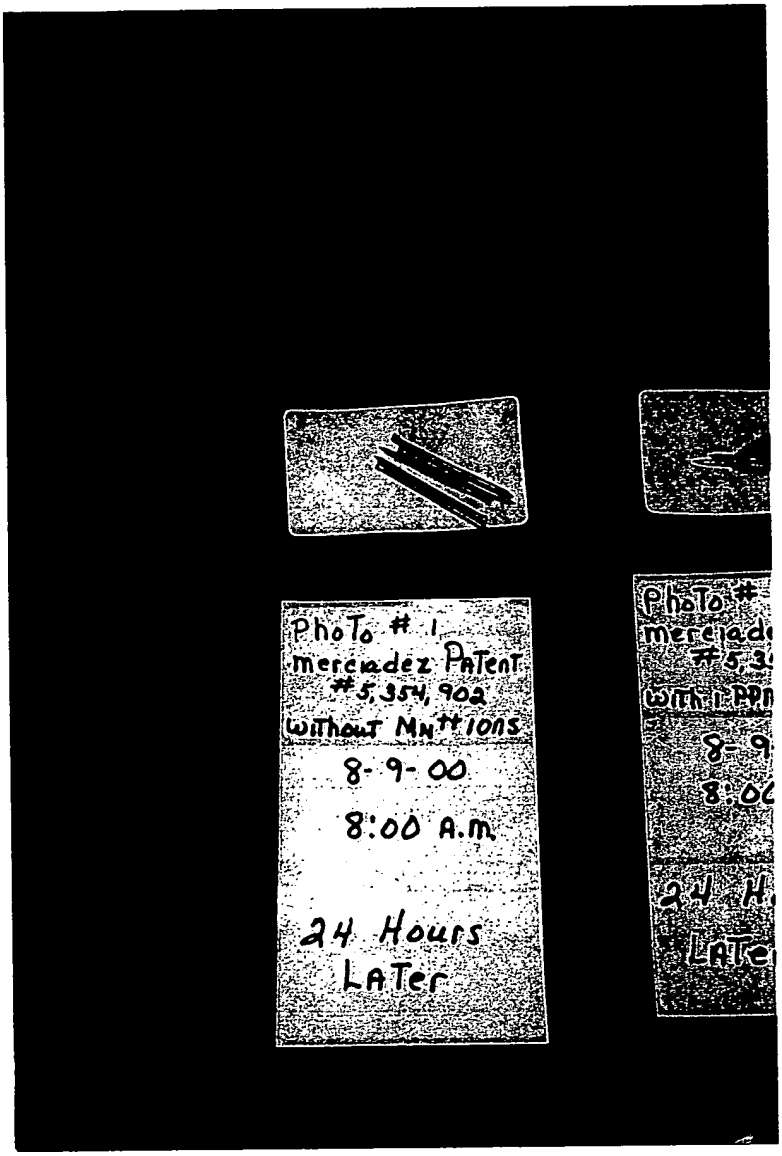
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#5,354,902
without MoTIONS
8-9-00
8:00 A.M.
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EXHIBIT G

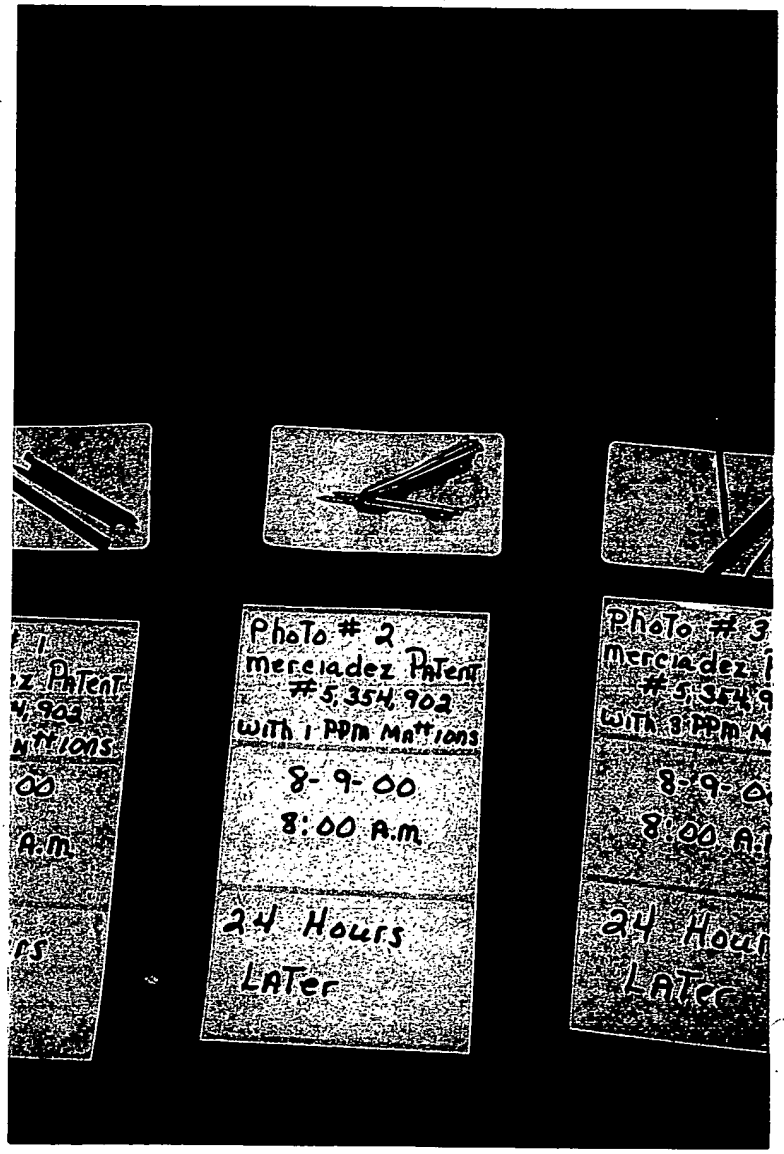
PhoTo # 2
mercadez PaTenT
#5,354,902
WiTh 1 PPM MaTTions
8-9-00
8:00 A.M.
24 Hours
LATer
PhoTo # 3
8-9-0
8:00 A.
24 Hou
LATe

EXHIBIT H

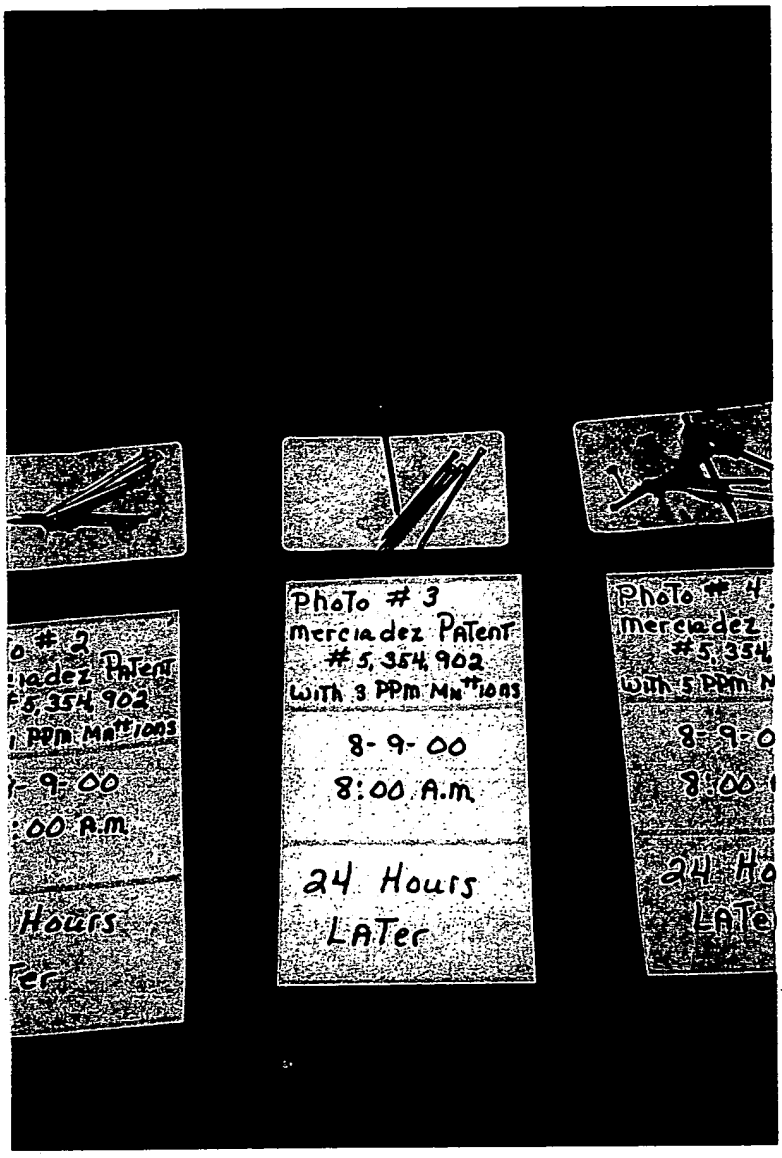
PhoTo # 3
mercIadez PATenT
#5,354,902
WiTh 3 PPm MnTIons
8-9-00
8:00 A.m
24 Hours
LATer

EXHIBIT I

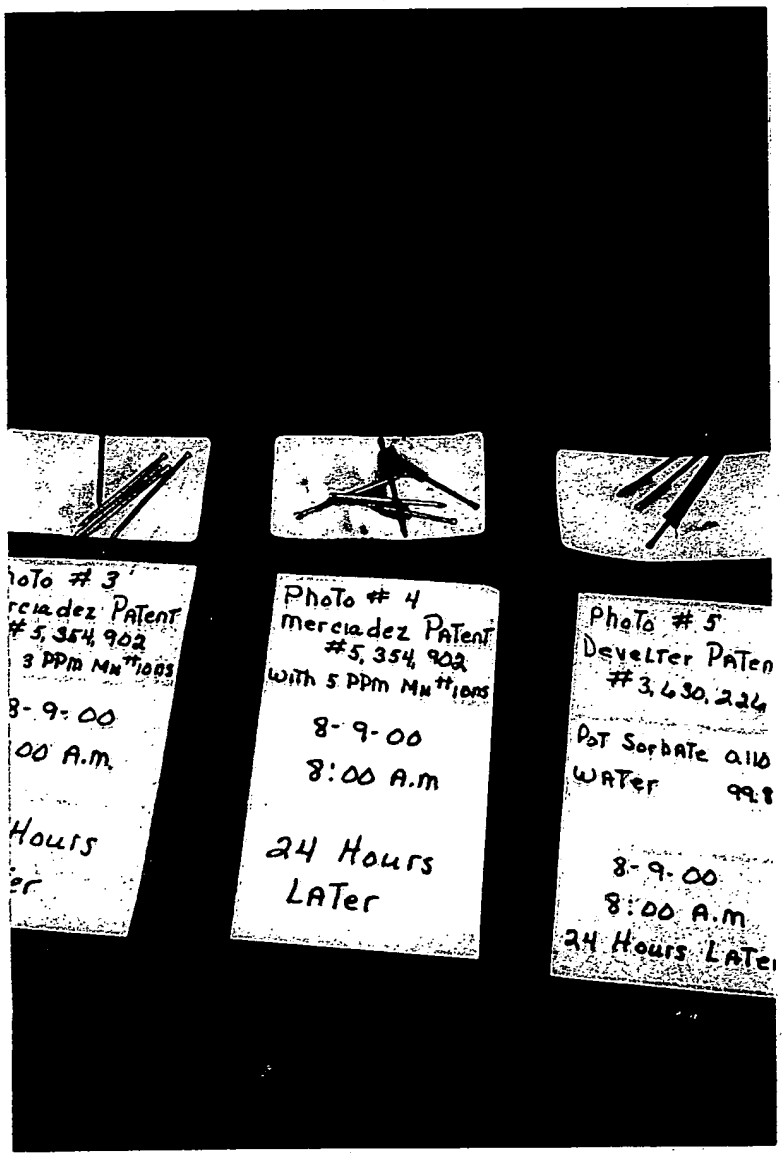
PhoTo # 4
merciadez PaTenT
#5, 354, 902
with 5 PPm MN++IONS
8-9-00
8:00 A.m
24 Hours
LATer
PhoTo # 5
DeveLTer PaTen
#3,630,226
PoT SorbaTe a1l0
WATer
8-9-00
8:00 A.m
24 Hours LATe

EXHIBIT J

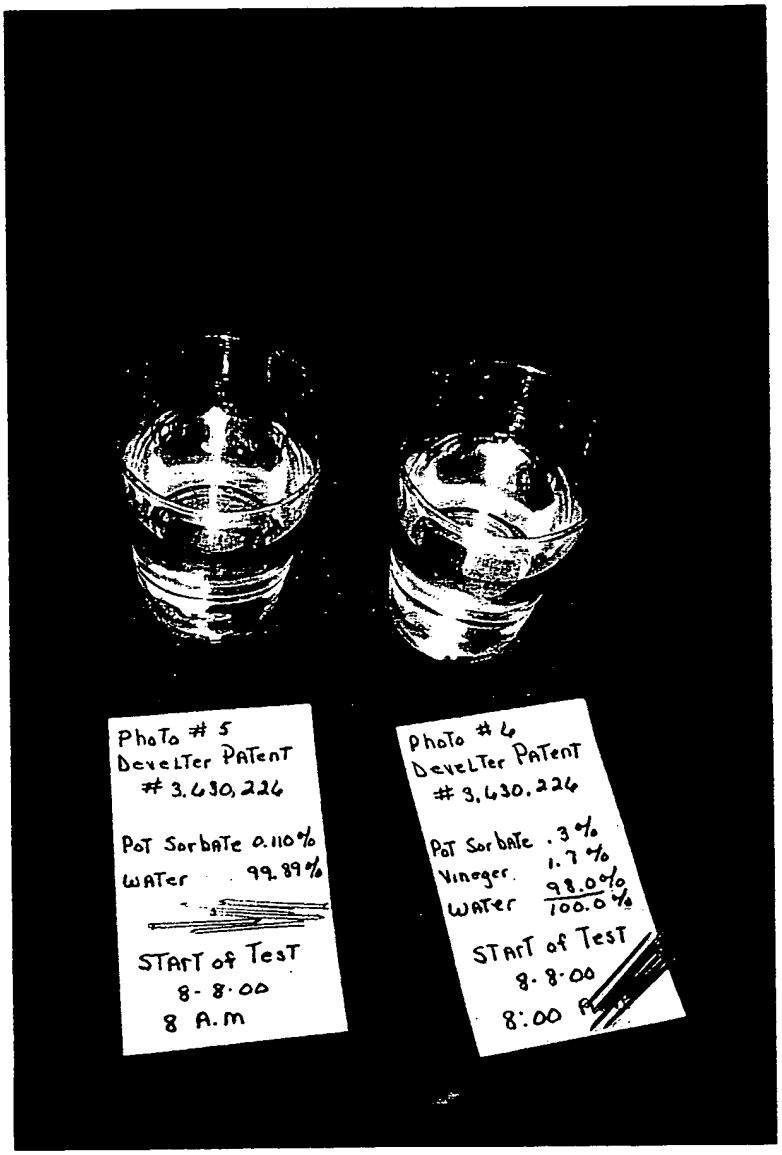
Photo # 5
Develter Patent
3,630,226
Pot Sorbate 0.110%
Water 99.89%
START of Test
8-8:00
8 A.M
Photo # 6
Develter Patent
3,630,226
Pot Sorbate .3%
Vinegar 1.7%
Water 98.0%
100.0%
START of Test
8-8:00
8:00 P

EXHIBIT K

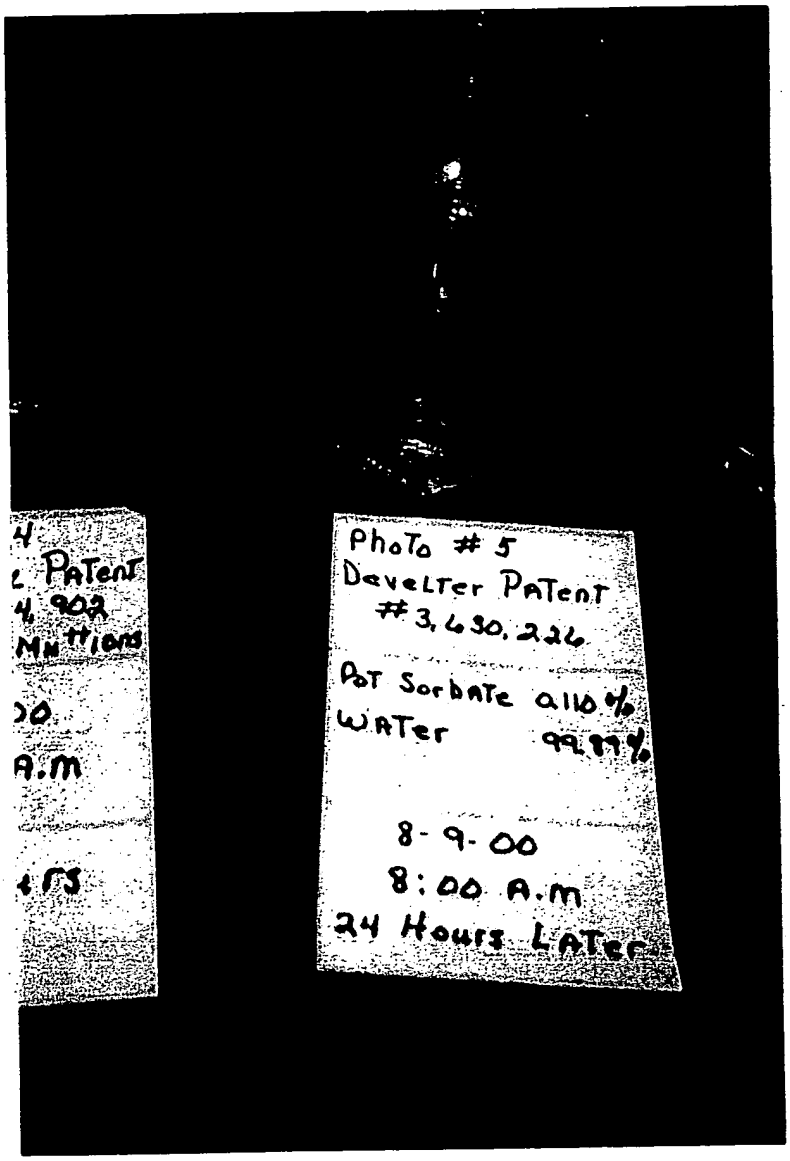
PATENT
4,902
MILLIONS
A.M
PHOTO # 5
DEVELTER PATENT
#3,430,226
POT SORBATE 0.110%
WATER 99.89%
8-9-00
8:00 A.M
24 HOURS LATER

EXHIBIT L

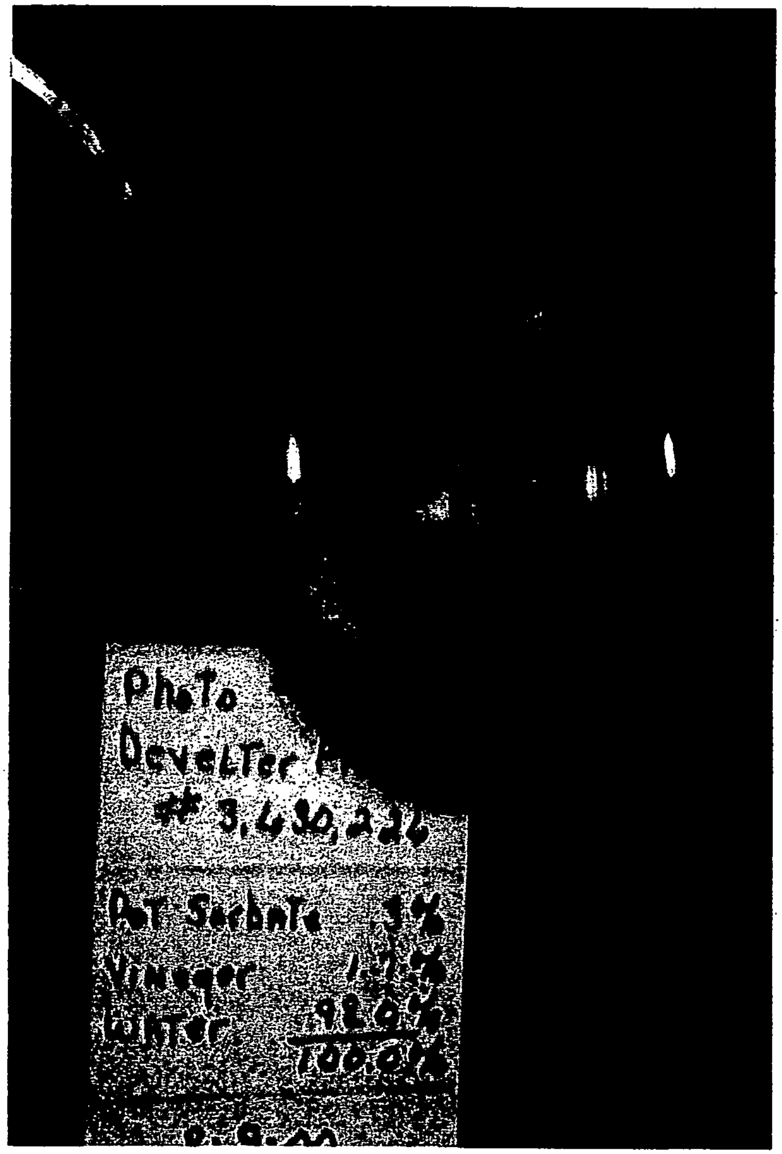

EXHIBIT M


Photo #5
Develter Patent
#3,650,226
Pot Sorbate .110%
WATER 99.89%
Photo #4
Develter Patent
#3,650,226
Pot Sorbate .3%
Vinegar 1.7%
WATER 98.0%
100.0%
8 9-00

EXHIBIT N

EXHIBIT O